

Serial No.: 09/973,458  
Attorney Docket No.: F-113

Patent

## **REMARKS**

### **1. Status of Claims**

Claims 13-37 were pending in the Application. Applicants have amended claim 16 without prejudice or disclaimer for purely cosmetic reasons to rewrite the allowed claim in independent form. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. The Amendments are submitted solely to place the present application in condition for allowance or in better condition for appeal. Applicants submit that no new matter is added. Accordingly, claims 13-37 will remain pending in the application.

### **2. Response to Arguments**

In section 2 of the Office Action, the Examiner purported to respond to the arguments of the Applicants.

Applicants respectfully disagree that the Ogg '808 reference is available as prior art for the cited concept. Applicants respectfully disagree with the Examiner's characterization of the references. Applicants respectfully disagree with the contention that Ogg '808 and Thiel '327 are properly combined as discussed further below.

With regard to the cited portion of Ogg at Col. 19, lines 27-45, Applicants have reviewed the underlying provisional applications and do not find support for that subject matter. For example, at pages 9-11 of Provisional Application 60/160,034, the icons are not inverted and there is no disclosure such as in FIG. 23-24 and the cited passage of Ogg '808. Accordingly, Applicants respectfully submit that Ogg '808 is not available as prior art for the cited concept and the rejections should be withdrawn.

Even if Ogg '808 were available as prior art, Ogg '808 does not teach or describe two virtual passes as suggested by the Examiner but rather suggests a replacement single pass.

Serial No.: 09/973,458  
Attorney Docket No.: F-113

Patent

With regard to the combination, Ogg '808 specifically teaches away from printing an envelope that cannot fit in one pass at Col. 22, lines 49-57 and thus there is a specific teaching away from the combination suggested by the Examiner and one of skill in the art would not look to Thiel '327 to modify Ogg '808.

Accordingly, Applicants respectfully request reconsideration in view of the above remarks.

### **3. Rejections under 35 USC § 103(a)**

In section 2 of the Office Action, the Examiner rejected Claims 13-15, 21, and 25-37 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,982,808 to Ogg, et al. ("Ogg '808") in view of U.S. Patent No. 6,389,327 to Thiel (Thiel '327").

Applicants respectfully traverse the rejection.

The Examiner has cited Ogg '808 as purportedly showing multiple pass printing, but Ogg '808 does not teach or suggest multiple pass printing as taught in the present application. At Col. 19, lines 17-45, Ogg '808 discusses rendering a print buffer for a single printing pass using multiple passes of a decision tree in software. The reference does not teach or suggest multiple physical passes of the print media through the feed path. In fact, the only suggestion is that a replacement single pass be generated.

With regard to the cited portion of Ogg at Col. 19, lines 27-45, Applicants discuss above the reasons that Ogg '808 is not properly cited as prior art in this case.

With regard to the combination, Ogg '808 specifically teaches away from printing an envelope that cannot fit in one pass at Col. 22, lines 49-57 and thus there is a specific teaching away from the combination suggested by the Examiner and one of skill in the art would not look to Thiel '327 to modify Ogg '808.

If the user selects "neither of these solutions work" from the plurality of options on FIG. 39, the system preferably informs the user that the current default printer does not support USPS requirements 202 and that the current printer is not able to print postage onto envelopes, only onto labels (see FIG. 40). A "Next>" button 204 may be

Serial No.: 09/973,458  
Attorney Docket No.: F-113

Patent

immediately available. When the Next button 204 is selected, the client software preferably disables printing to envelopes 206 (see FIG. 33).

Accordingly, if the system of Ogg '808 cannot print in one physical pass, it gives up. It does not attempt to use two physical passes. Accordingly, the references are not properly combined and the rejection should be withdrawn.

Applicants have previously amended claims 13, 21, 25 and 34 to clarify the multiple physical path elements for cosmetic reasons without changing the scope of the claims. The respective dependent claims are patentable over the cited reference for at least the same reasons stated above.

Accordingly, for at least the reasons stated above, claims 13-37 are patentable over the cited references.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection and submits that the invention as presently claimed in claims 13-37 is patentable and in condition for allowance.

#### **4. Allowable Subject Matter**

In section 3 of the Office Action, the Examiner states that claims 16-20 and 22-24 contain allowable subject matter. Applicants appreciate the indication of allowability and have amended claim 16 to rewrite the claim in independent form.

#### **5. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

Serial No.: 09/973,458  
Attorney Docket No.: F-113

Patent

### 6. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-113.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-113.

Respectfully submitted,



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